

Claim 1 is an independent claim.

Claims 9-14 are newly added claims.

### **INFORMATION DISCLOSURE STATEMENT**

The notation that the Information Disclosure Statement has been fully considered is noted.

### **DRAWINGS**

The indication that the drawings were accepted by the Draftsperson as filed is noted.

### **Drawing Correction Required by the Examiner:**

In the drawings, Fig. 5 was objected to because it was asserted that "6A" should read 13 and "6B" should read 13.

Accompanying this Reply is a letter for correcting the drawings, making the changes requested by the Patent Office.

It is requested that the Examiner approve these drawing changes but hold them in abeyance until this application is allowed.

### **OBJECTION TO THE SPECIFICATION**

In section 2 of the Office Action, there were listed some objections to the specification. The Examiner's attention to the details of the specification is appreciated.

The changes requested by the Patent Office have been made as well as other editorial changes.

The Examiner is requested to reconsider and withdraw the objection to the specification.

### **REPLY TO REJECTIONS**

Claims 1 and 2 were rejected under 35 U.S.C. §102(b) as being anticipated by anyone of Sanbayashi et al (U.S. Patent No. 5,349,816, "hereinafter, Sambayashi") or Kato et al. (U.S. Patent No. 5,600,949, "hereinafter Kato"). This rejection is traversed.

The alternative rejection set forth in section 4 of the Office Action will be treated initially in separate arguments.

#### **Reply to the Rejection on Sambayashi:**

In rejecting the claims over Sambayashi, the Office Action asserts that 10 is a gas purifying means, 9 is a light-off catalyst and 3, a control means.

Even assuming arguendo, the reference shows these elements, the subject matter as a whole is not shown in the reference. It appears that the most pertinent disclosure in

this reference is found in column 5, line 17-66.

While the Office Action asserts that the light-off catalyst has a lower storage ability than the exhaust gas purifying means, this is not clearly shown in the pertinent portion of the reference noted above. The PTO is requested to point out the portion of the reference relied on. (See *In re Yates*, 663 F.2d 1054, 211 USPQ 1149, 1151) (CCPA 1981) which stated as follows: (when the PTO asserts there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such teaching or suggestion appears in the reference). underline added

col. 5  
line 21-23  
cat. 9 is smaller  
than 10

It appears that the Patent Office may be relying on probability or possibility that this structure exists, considering the most pertinent disclosure of the reference. But a rejection under 35 U.S.C. §102 is not viable if each and every limitation of the claims is not found in the reference. A rejection under 35 U.S.C. §102 may not rely on the possibility or probability. See *Continental Can Co. v Monsanto* 20 USPQ 2<sup>nd</sup> 1746(1749) Fed Cir. 1991 where in the courts stated as follows:

Inherency . . . may not be established by probabilities or possibilities.  
The mere fact that a certain thing may result from a given set of  
circumstances is not sufficient. . . ;"

**Reply to the Rejection on Kato:**

In rejecting the claims, the Patent Office asserts that elements 16 and 17 of Kato are an exhaust gas purifying means and that element 15 is a light-off catalyst.

Even assuming *arguendo* that Kato shows this structure, Kato does not show each and every limitation set forth in the claims, as explained *supra* with respect to the rejection on Sanbayashi, and accordingly a rejection under 35 U.S.C. §102 is not viable. (See also the cases cited *supra*)

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejections under 35 U.S.C. §102.

**Second Rejection:**

Claims 3 and 4 were rejected under 35 U.S.C. §103(a) as being unpatentable over any one of Sanbayashi et al or Kato et al. in view of design choice. This rejection is traversed.

Initially as explained *supra*, Sanbayashi or Kato does not show what has been claimed in claims 1 and 2. Also, as set forth in the specification the structure of the relative, oxygen storage capabilities of the light-off catalyst and the exhaust gas purifying means is important, See the specification, page 5, line 6 to page 6, line8.

Additionally, the added feature of the amount of oxygen absorbed is an important feature of the claimed device as set forth on page 6, line 27 to page 7, line 2 of the specification.

While the Office Action has asserted this is a "design choice", no evidence has been provided to support this assertion. Additionally, the matter of design choice is not viable

when there is a difference between the function claimed and the prior art. See *In re Chu* 36 USPQ 2<sup>nd</sup> 1089, 1095 (Fed Cir. 1995) wherein the court stated as follows:

Finding of "obvious design choice" precluded when claim structure and the function it performs are different from the prior art.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claims under 35 U.S.C. § 103.

#### **NEW CLAIMS**

New claims 5-14 have been added. These claims are considered patentable at least for the same reasons as their base claims or intervening claims. The art applied does not show or suggest the structure of these new claims.

#### **CONCLUSION**

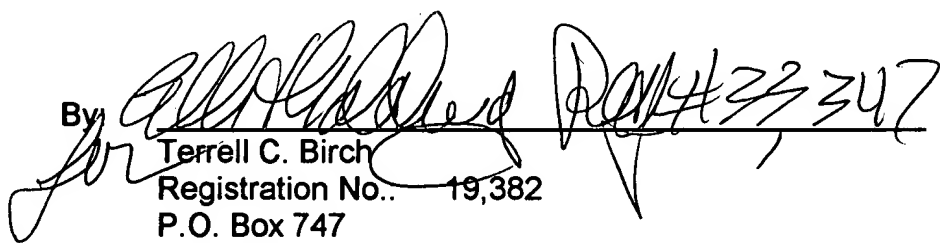
If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Mr. Elliot Goldberg at (703) 205-8000 in the Washington, D.C. area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By

A handwritten signature in black ink, appearing to read "Terrell C. Birch", is written over a horizontal line. To the right of the signature, the number "19,382" is handwritten in a similar style.

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